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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,109	07/12/2000	David Stevanovski	TIC-10402/08	1567

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EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/614,109

Applicant(s)

STEVANOVSKI ET AL.

Examiner

Daniel S Felten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-37 and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-37 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt of the Request for continued Examination ("RCE") filed March 09, 2005. Claims 19, 22 23, 26, 27, 34 canceling claim 38 and adding claim 39 are pending in the application and are provided. Claims 19-37 and 39 are pending in the application and are presented to be examined upon their merits.

Response to Arguments

2. Applicant's arguments filed March 05, 2005 have been fully considered but they are not persuasive. The rejections of claims 19-33 are maintained. Upon consideration of the amendments presented to the applicant, particularly in claim 19, "*creating a merchant file in the database, the merchant file having banking information*". This limitation represents Non-functional descriptive material. MPEP 2106 IV B1 (b) indicates that "non-functional descriptive material is material that can not exhibit any functional interrelationship with the way computing processes are performed." In this case, there is no functional relationship between creating the merchant file having banking information and how this is used to administer payment of obligations of a customer. Thus non-functional descriptive material can not render non-obvious an invention that would have otherwise been obvious [see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir 1983)]. Thus the rejection of claims 19-33 are maintained. Further rejections of the claims are made below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 26, 27, 35, 36, and 39, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claims 26, 27, 35, 36, these claims cite the limitation of a “dollar limit threshold” one of ordinary skill in the art would not understand the parameters or the metes and bounds of this limitation.

Re claim 39, the claim cites the limitation of a “system”. The word system is a has connotations that cross over the statutory categories of both a method and an apparatus. Since the body of the claim has both limitations of both a method and an apparatus the claim is ambiguous. Is the applicant claiming a method or an apparatus? To expedite prosecution of the application the Examiner has chosen to consider claim 39 as an apparatus claim unless otherwise mentioned by the applicant.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 34-37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce (US 4,485, 300) in view of Lawlor (US 5,220, 501). The rejection below is made in consideration of the newly presented claim language.

As in claims 34 and 39, administering payments for transaction made by a customer that is a consumer of goods or services from a merchant, providing an administrator (see Pierce, col. 4, ll. 50-65; and col. 6, ll. 1-25)

Creating a database in electronic communication with the administrator (see Pierce, col. 4, ll. 50-65), having a customer file and a merchant file (see Pierce, col. 8+ and col. 32+; Lawlor, col. 19, ll. 54+), the customer file including a purchase parameter (see Pierce, col. 1, ll. 16+), the merchant file having a merchant account number and a merchant category assigned thereto;

Creating an administrative program in electronic communication with the administrator and having a merchant approval program (see Pierce col. 6, ll. 44+),

Pierce fails to disclose that the merchant approval program being operable to query the purchase parameters in response to an approval request. This is disclosed by Lawlor (see Lawlor, col. 20, ll. 44+). It would have been obvious for an artisan of ordinary skill at the time of the

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invention to provide the aforementioned feature to provide the user with pertinent information.

Thus such a modification would be an obvious expedient well within the ordinary skill in the art.

Regarding claims 35-37. See explanation above

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF
May 25, 2005

Daniel S Felten
Examiner
Art Unit 3624

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

